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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/895,936	07/17/97	WISNEIEWSKI	R 17882706

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EXAMINER

FORD, J

ART UNIT

PAPER NUMBER

3743

15

DATE MAILED:

10/15/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 7-26-99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-20, 22-35 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20, 22-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Regarding the drawings, they are, in fact, at times illegible. For purposes of the election requirement which follows, the Examiner was at times forced to guess at the numbering of the Figures as well as reference numerals in the Figures. If applicants possess a set of drawings with darker reference numerals and complete numbering corresponding to the numbering found on page 8, line 16 - page 10, line 2 of the specification, they should be submitted in response to this office action.

Applicants argue that the term "biopharmaceutical product" makes what is otherwise an inanimate container with a heat exchanger in it patentable by virtue of the feature of the material intended to be conditioned.

It is respectfully submitted that the patentability of an apparatus cannot be predicated on a new use of what is otherwise an old apparatus. This is very old case law. See Brown v. Piper 91 U.S. 37, 23 LED.200 (1875), and Roberts v. Ryer 91 U.S. 150, 23 LED 267 (1875). See In re Thuau 57 USPQ 324 (CCPA 1943) for the leading new case and Ex Parte Masham 2 USPQ2d 1647 (BPAI 1987).

This application contains claims directed to the following patentably distinct species of the claimed invention: first species of Fig. 1 and 2,

second species of Fig. 4,

third species of Fig. 5,

fourth species of Fig. 6,

fifth species of Fig. 7,

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sixth species of Fig. 8,
seventh species of Fig. 9, (more than one, maybe),
eight species of Fig. 10,
ninth species of Fig. 11 and 12,
Tenth species of Fig. 13,
eleventh species of Fig. 14 and
twelveth species of Fig. 15 and an in determinant number of additional
species illustrated in Figure 16-19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear to be generic.

In the event applicants elect any figure which has numerous variants associated with it, a particular variant must be enumerated.


Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication should be directed to John Ford at telephone number (703) 308-2636.



John K. Ford
Primary Examiner

J. FORD:LM
JUNE 18, 1999